

REMARKS

Favorable reconsideration of this application as presently amended and in light of the following discussion is respectfully requested.

Claims 1-32 are presented for examination. Claims 1, 9, 14, 19, and 23 have been amended to emphasize existing claim requirements that it is the claimed set top box (STB) server device that has the drive that stores game software, not the game executing device that is configured as a game controller, all as further clearly supported by the description at page 18, line 15-page 19, line 23 of the specification, for example. As these amendments simply emphasize existing claim requirements, it cannot be said that entry of this amendment would involve new issues or require a further search. Accordingly entry of this amendment under 37 CFR §1.116 is believed to be in order.

The outstanding Office Action presents a rejection of Claims 1-32 under 35 U.S.C. § 103(a) as being unpatentable over Crawford (U.S. Patent No. 5,771,354) in view of Schindler et al (U.S. Patent No. 5,675,390, Schindler).

The present invention includes, *inter alia*, a game executing device configured as a game machine system including a game controller without game software storage, a television receiver serving as a display device, and a set top box (STB) that receives a television satellite broadcast signal to supply television program data corresponding thereto to the television receiver serving as the display device. The STB is provided with a server device having a hard disk that for storage of game software received via the STB. The STB, display device, and the game executing device forming the game machine system are connected to each other via a digital communication line that is external to each of these devices. The game machine system

executes a game by accessing the hard disk in the STB server to read the game software instead of a CD-ROM, DVD or other packaged media.

Turning to the outstanding rejection of Claims 1-32 as being anticipated over Crawford in view of Schindler, it is noted that requirements of independent base Claims 1, 9, 14, 19, and 23 have been ignored in clear violation of established precedent cited in the last response (see again In re Wilson, 165 USPQ 494, 496 (CCPA 1970) requiring that “[a]ll words in a claim must be considered in judging the patentability of that claim against the prior art”) and improperly ignored in the outstanding Action.

In this last regard, each of the independent base Claims 1, 9, 14, 19, and 23 (and the claims dependent thereon) require not only a set box top (STB), that cannot be reasonably read as “merely a computer that is associated with the cable television system” as incorrectly noted on page 2 of the outstanding Action, they also require, *inter alia*, a digital communication line that is external to each of the STB, a display device, and a game executing device **that interconnects these devices to form a game machine system.**

As was noted in the last response, it is completely unreasonable and clear error to attempt to equate any of the customer computers 50 (which would include Customer Z computer 50 (Z) of FIG. 4 with the STB of Claims 1-32 because the STB of base independent Claims 1, 9, 14, 19, and 23, must perform the claimed functions of receiving a television satellite broadcast signal and supplying television program data corresponding to the received television satellite broadcast signal to a display device. The Crawford computer 50(Z) cannot be said to be a “set top box” as erroneously stated on page 2 of the outstanding Action because it is not taught or suggested to perform the claimed function of receiving a television **satellite**

broadcast signal and supplying television program data corresponding to the received television satellite broadcast signal to a display device. In this regard, the Crawford FIG. 4 showing is that there is a Cable TV Connect 134 to computer 50(Z) and clearly suggests a cable, not a satellite source. Column 16, lines 39-43 do indicate data can be supplied between two switching stations 124a, 124b "by means of satellite" but further clarify that this is ONE ALTERNATIVE to the other links listed like the cable TV link 134, noted at column 16, lines 41-43. Thus, it is clear to the artisan that the link via 134 is a cable link, and that this cable connect receives a CABLE (not SATELLITE) signal and decodes it to supply a standard TV program signal to computer 50 (Z), contrary to the unsupported assumption at page 3 of the outstanding Action.

The clear error of the PTO attempted interpretation of any computer as somehow inherently performing as the claimed STB is further clear from the relied upon Schindler reference that makes it clear that those of ordinary skill in the art are aware that "set top box" (STB) is a term of art with the plain meaning of a device providing an integrated receiver/decoder to convert input satellite broadcast signals to standard NTSC TV signals. See column 3, lines 6-21 of Schindler and note that no hint of any hard drive for software storage, or any other storage, is taught or suggested. As noted by the PTO reviewing court in In re Cortright, 49 USPQ2d 1464, 1467 (Fed. Cir. 1999):

Although the PTO must give claims their broadest reasonable interpretation, this interpretation must be consistent with the one that those skilled in the art would reach. [citations omitted] Prior art references may be "indicative of what all those skilled in the art generally believe a certain term means . . . [and] can often help to demonstrate how a disputed term is used by those skilled in the art." *Vitronics Corp. v. Conceptronic, Inc.*, 90 F.3d 1576, 1584, 39 USPQ2d 1573, 1578-79 (Fed. Cir. 1996). Accordingly, the PTO's interpretation of claim terms should not be so broad that it conflicts with the meaning given to identical terms in other patents from analogous art [citation omitted].

Moreover, the outstanding Action commits further clear error in also ignoring that independent base Claims 1, 9, 14, 19, and 23 (and the claims dependent thereon) require, *inter alia*, a digital communication line that is external to each of the STB, a display device, and a game executing device **that interconnects these devices to form a game machine system**.

In this regard, while display device 54 of Crawford is taught to display images, and mouse 58 and keyboard 56 are taught as standard computer peripherals, there is no teaching or suggestion in Crawford that data link 150 is used in any way to interconnect any of 54, 56, or 58 to the main processor unit 52 housing the hard drive. In accordance with In re Rijckaert, 28 USPQ2d 1955, 1957 (Fed. Cir. 1993) ("When the PTO asserts that there is an explicit or implicit teaching or suggestion in the prior art, it must indicate where such a teaching or suggestion appears in the reference.") the PTO is called upon to state where the relied upon interconnection of 52, 54, 56, and 58 by 150 can be found in Crawford. Note further the dictates of In re Lee, 61 USPQ2d 1430, 1434 (Fed. Cir. 2002) as to the obligation of "the agency to make the necessary findings and to provide an administrative record showing the evidence on which the findings are based, accompanied by the agency's reasoning in reaching its conclusions" (emphasis added, citation omitted).

In addition to the above, and as noted in the last response, the outstanding Action again inappropriately attempts to lift the description of the prior art at column 2, lines 15 and 16 and transpose it into the disclosure of the Crawford system of Figs. 1 and 3 without any statement by Crawford that the download of new video games provided by the noted information providers is to be incorporated into the improved and different on-line service that Crawford

proposes. The Crawford teaching is of a system for "executing host based software on the remote user's system directly or for a user's locally executing application to directly access storage on the host system," see col. 7, lines 56-60, with no mention that the downloading of video games is to be included in the Crawford system to be found here or elsewhere in Crawford. As noted in In re Kotzab, 55 USPQ2d 1313, 1317 (Fed. Cir. 2000), "... a rejection cannot be predicated on the mere identification in [one reference] of individual components of claimed limitations. Rather, particular findings must be made as to the reason the skilled artisan, with no knowledge of the claimed invention, would have selected these components for combination in the manner claimed."

Further in this last regard, the question is of "obviousness" under 35 U.S.C. §103 of adding the downloading of new video as noted relative to previous service providers to the Crawford taught system. As noted by the court in In re Rouffet, 47 USPQ2d 1453, 1457 (Fed. Cir. 1998)

As this court has stated, "virtually all [inventions] are combinations of old elements." *Environmental Designs, Ltd. v. Union Oil Co.*, 713 F.2d 693, 698, 218 USPQ 865, 870 (Fed. Cir. 1983); see also *Richdel, Inc. v. Sunspool Corp.*, 714 F.2d 1573, 1579-80, 219 USPQ 8, 12 (Fed. Cir. 1983) ("Most, if not all, inventions are combinations and mostly of old elements."). Therefore an examiner may often find every element of a claimed invention in the prior art. If identification of each claimed element in the prior art were sufficient to negate patentability, very few patents would ever issue. Furthermore, rejecting patents solely by finding prior art corollaries for the claimed elements would permit an examiner to use the claimed invention itself as a blueprint for piecing together elements in the prior art to defeat the patentability of the claimed invention. Such an approach would be "an illogical and inappropriate process by which to determine patentability." *Sensonics, Inc. v. Aerosonic Corp.*, 81 F.3d 1566, 1570, 38 USPQ2d 1551, 1554 (Fed. Cir. 1996).

Thus, merely noting that something was known does not supply the required showing as to motivation for making a modification to the invention disclosed by the reference and the PTO must demonstrate how the Crawford teaching of that it was previously known to include video

game downloading would have led the artisan to modify the Crawford system, where the mere mention of a video game downloading service as a previously provided service is still not seen to be a teaching that this service is to be included in the system proposed by Crawford.

Also, to whatever extent that column 3, lines 6-21 of Schindler teaches a “set box top” device with an integrated receiver/decoder function for receiving satellite signals to standard TV signals, this is not what device 118 is. Instead, 118 is described as a personal computer or other processing circuitry that will replace such a set top box and numerous other devices if properly programmed to do so. See column 7, line 58-column 8, 18, for example.

Moreover, the artisan would not be reasonably led by the teachings of Schindler to modify Crawford because to do so would destroy the basic operation flexibility of the Crawford invention in terms of desired its versatile data link 150 not limited to just the TV satellite source that is taught by Schindler. Any proposed modification that would change the basic operating principle of a reference is not an obvious one. See In re Ratti, 123 USPQ 349, 352 (CCPA 1959). Moreover, reference modifications that would render a reference unsatisfactory for its intended purpose are also not obvious. See In re Gordon, 221 USPQ 1125, 1127 (Fed. Cir. 1984).

Furthermore, even if the artisan had some valid reason, a reason not set forth in the outstanding action, to attempt to modify the Crawford system to be a satellite only system as taught by Schindler, the result would still not establish a valid *prima facie* case of obviousness because neither Crawford nor Schindler teach or suggest the above-noted STB, display device, and the game executing device being connected to each other to form the game machine system via a digital communication line that is external to each of the STB, the display device, and the game executing device.

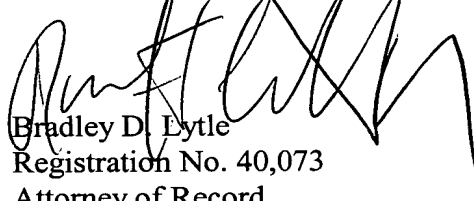
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As Claims 3-8, 10-13, 15-18, 20-22, and 24-32 depend ultimately from one or the other of independent base Claims 1, 9, 14, 19, and 23, they include the above-noted limitations of these independent claims that are clearly not taught or suggested by Crawford. In addition, these dependent Claims 3-8, 10-13, 15-18, 20-22, and 24-32 all include additional recitations that are not taught or suggested by Crawford and, accordingly, cannot be said to be anticipated by Crawford for this reason as well.

Accordingly, as no other objections or rejections remain outstanding, it is believed that this application is clearly in condition for formal allowance and an early and favorable action to this effect is, therefore, respectfully requested.

Respectfully submitted,

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